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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,016	07/08/2003	Marie-Laure Delacour	05725.1224-00	9511
22852	7590	12/08/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			CHANNAVAJALA, LAKSHMI SARADA	
		ART UNIT	PAPER NUMBER	
			1615	

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/614,016	DELACOUR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lakshmi S. Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 August 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-63 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11-21-03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

Receipt of response to election requirement dated 8-21-06 is acknowledged.

Claims 1-63 are pending.

Upon reconsideration, the restriction/election requirement dated 7-20-06 has been withdrawn and all the pending claims have been considered for examination.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,565,862.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Instant claims recite a cosmetic composition comprising a binder A comprising water and particles of cross-linked elastomeric organosiloxane, and a particulate phase. The patented claims recite a solid make up composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase, and a particulate phase containing pigments pearlescent agents, fillers and mixtures thereof, all of which have been claimed in the instant application. Dependent claims of the cited patent recite the particle sizes of the organosiloxane and further recite additional ingredients such as aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. While the patented claims do not recite the exact ratios of the instant claims, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the individual components of the composition of the patented claims because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

Claims 1- 63 directed to an invention not patentably distinct from claims 1-26 of U.S. Patent No. 6,565,862. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,403,704, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting

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inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

2. Claims 1-63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Instant claims recite a cosmetic composition comprising a binder comprising water and particles of cross-linked elastomeric organosiloxane, and a particulate phase. The patented claims recite a make-up composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase and the patented composition is also used for the same cosmetic purposes claimed in the instant application. Dependent claims of the cited patent recite the particle sizes of the organosiloxane, aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. Further, the dependent claims of

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the patent (48-54) recite fillers, nacres and pigments respectively, which are defined by the patent as particulate materials and include the claimed fillers and pigments respectively and include the same materials that are claimed in the instant applications. Furthermore, the patented claims same cosmetic forms or products such as solid cosmetic or a foundation that are within the scope of the instant claims. While the patented claims do not recite the exact ratios of the instant claims, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the individual components of the composition of the patented claims because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

Claims 1- 63 directed to an invention not patentably distinct from claims 1-63 of commonly assigned US 6,689,345. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,689,345, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35

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U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

3. Claims 1-16, 32-60, 62 and 63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,403,704 and claims 1-42 of US 7,094,842. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Instant claims recite a cosmetic composition comprising a binder A comprising water and particles of cross-linked elastomeric organosiloxane, and a particulate phase. The patented claims recite a method of increasing water resistance of a composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase. Dependent claims of the cited patent recite the particle sizes of the organosiloxane similar to that claimed in the instant application. Dependent claim 13 of the above patent '704 recites a particle phase similar to the instant and further the patented composition is also used for the same cosmetic purposes claimed in the instant application. The patented claims further recite additional ingredients such as

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aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. Similarly, '842 claim composition comprising the instant elastomeric silicone polymer in an aqueous phase and adjuvants such as fillers, pearlescent agents etc (claim 31 and 32). While the patented claims do not recite the exact ratios of the instant claims, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the individual components of the composition of the patented claims because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

Claims 1-16, 32-60, 62 and 63 directed to an invention not patentably distinct from claims 1-18 of commonly assigned 6,403,704 & claims 1-42 of US 7,094,842. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,403,704 & 7,094,842, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions

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were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,403,704 ('704) or US 6,689,345 ('345) or US 6,565,862('862) or US 7,094,842 ('842) or US 6,184,277 ('277).

'704 teach cosmetic skin care compositions comprising particles of at least a partially crosslinked elastomeric polyorganosiloxanes suspended in an aqueous phase, wherein the polymer dryness as well as a matte finish to the cosmetic composition when applied (col. 2, L 23- 59). Both instant specification and '704 refer to the same polysiloxane compounds described in JP-A-10/175816 application for the suitable polyorganosiloxanes compounds that are suitable for the instant invention, particularly,

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those sold under the trade names BY-29-122, BY-29-119 (also disclose in the instant specification) (col. 3, L 37-59 & col. 4, L 10-40) having the same hardness and particle sizes recited in the instant claims. For microcrystalline wax of claims 32 -35, see col. 5, L 50-55. For volatile oils of claims 36-38, see col. 4, last paragraph through col. 5. For gelling agents of claims 39-43, see col. Col. 6, 14-40. For the pigments, fillers and nacres (read on instant pearlescent agents) see entire col. 7. '704 teach preparing the composition by a screw extruder mixer and thus meet claimed method of preparing the composition (claims 51-60), where the polyorganosiloxanes is added to water and mixing with the pigment or filler materials that are particulate in nature. '704 further teach the same solid compositions claimed (col. 49-59). '704 do not teach the claimed ratios of the particulate phase and binder. However, '704 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '704 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'862 also teach cosmetic composition comprising the claimed binder and particulate material and for the preparation of the same cosmetic compositions such as

those claimed. The disclosure of '862 and '704 are similar in that the former also teach the same polymers as suitable for binder phase, and also teach the fillers, pigments, nacres, fatty phase, waxes and gelling agents etc. '862 also describe the same advantages such as those described by '704 with the composition. '862 fail to teach the claimed ratios or percentages of the components A, B and C. However, '862 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '862 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'345 cosmetic compositions comprising the claimed organosiloxane elastomeric polymers (col. 4, L 55 through col. 6, L 67) and are similar to those of '704 and '862. '345 also teach the claimed fatty phase, particle sizes (col. 7), containing microcrystalline wax (col. 8, L 56-65), gelling agents (col. 8, L 38 through col. 9, L 20), particulate pigments, fillers, nacres (col. 9) and the same method of producing the composition (twin screw extruders- col. 10). '345 fail to teach the claimed ratios or percentages of the components A, B and C. However, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the

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composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '345 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

The disclosures of '277 and '842 are similar to '345, '704 and '862 in that the former also teach the claimed compositions. '277 and '842 fail to teach the claimed ratios or percentages of the components A, B and C. However, both the patents ('842 and '277) teach the percentages of the organosiloxane polymer, pigments, fillers or nacres and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, they teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

5. Claims 1-20, 25-26, 28-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,928,660 to Kobayashi et al ('660).

'660 teach a cosmetic comprising an aqueous suspension of a powdered silicone rubber, wherein the silicone rubber is an organopolysiloxane (abstract, col.2, L 42-58) and the surface of the silicone is covered with a fine inorganic powder giving good stability to the cosmetic composition. While '660 does not teach the claimed hardness of the polymer, the references teaches the same polymers as disclosed in the instant invention and hence in the absence of evidence to the contrary, the polysiloxane of Among the inorganic powders, '660 teach the pigments and fillers of the instant claims 17-20, 25-26 and 28-31 (col. 4, L 65- col. 5, L26) and suggest adding the particulate powders in an amount of 0.1 to 50 parts. '660 teach compositions in the form of foundation, eye shadow, etc., claimed in the instant application (col. 5, L 55 through col. 6, L 9). '660 further teaches incorporating fatty materials comprising oils, waxes (such as microcrystalline wax); pigments, thickeners such as gums, polyacrylate etc in the composition (entire col. 6 and examples in col. 9-10). '660 fail to teach the specific percentages or the ratios of organopolysiloxane, particulate powders, waxes and gelling agents etc. However, '660 teach preparation of solid cosmetic compositions such as those claimed in the instant and suggests that the silicone containing cosmetic raw material imparts uniformity and stability to the cosmetic composition. Further, '660 also suggest that the stability is a function of the amount of inorganic powders coating the silicone rubber and the amount of the silicone rubber. Accordingly, optimizing the amounts or ratios of the particulate powders, silicone rubber with an expectation to

achieve a stable composition would have been within the scope of a skilled artisan. Further, optimizing the amounts of the cosmetic adjuvants such as waxes, thickeners depending on the type of cosmetic being prepared i.e., a solid foundation, eyeliner etc., would have been within the scope of a skilled artisan.

6. Claims 21-24 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,853,711 to Nakamura et al (Nakamura), as applied to 1-16, 25-26, 32-59 and 61-63 above, and further in view of JP 2001199828 (JP, submitted on PTO-1449).

'660 fail to teach the claimed pearlescent and coated particulate materials. JP (abstract) teaches solid cosmetic compositions comprising organopolysiloxane, talc, red iron oxide, agar etc., all of which have been claimed in the instant application. JP also teaches incorporating a flouro-compound treated titanium oxide that reads on the instant pearlescent agent and the coated compounds of instant claims. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use the polysiloxane containing raw material of '660 in preparing cosmetic compositions such as foundation composition by adding the flouro coated titanium oxide and other pigment components of JP because, both '660 and JP are directed to solid cosmetic compositions comprising organopolysiloxane thus constituting analogous art and while '660 suggests stability of the composition, JP suggests improved use feel and moisturizing effect.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Specification***

The use of the trademark Nylon® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claims 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Instant claims recite the trademark product Nylon ®, which is indefinite.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit 1615  
December 5, 2006

  
LAKSHMI S. CHANNAVAJJALA  
PRIMARY EXAMINER